(dem)

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte CARL L. WILLIS

Appeal No. 94-0997
Application 07/529,304[1]

ON BRIEF

Before GOLDSTEIN, TURNER, and WARREN, *Administrative Patent Judges*.

GOLDSTEIN, *Administrative Patent Judge*.

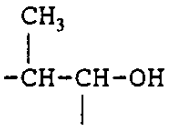
---

[1] Application for patent filed May 29, 1990.

DECISION ON APPEAL

This appeal is from the examiner's final rejection of claims 1 to 3 and 14 to 20. Claims 8 to 13 have been allowed, and claims 4 to 7 have been indicated as being drawn to allowable subject matter if their dependency were suitably modified. Illustrative claims 1 and 14 are reproduced below.

1. A polymer comprising polymerized 1,3-butadiene units and both carboxylic ester groups and alcohol linking groups, the ester groups being pendent from backbone carbon atoms and the alcohol linking groups having the following structure:



which connects two backbone carbon atoms.

14. A process for hydrogenating a polymer or copolymer containing ketone groups, comprising the steps of:

contacting the polymer or copolymer with hydrogen in the presence of a catalyst which comprises a cobalt compound, selected from cobalt 2-ethylhexanoate, cobalt acetate, and cobalt carbonyl, and an alkyl aluminum compound; and

recovering the polymer or copolymer after sufficient time for conversion of ketone groups to alcohol groups.

The sole reference relied on by the examiner on appeal is:

Willis	4,981,916	Jan. 1, 1991

Claims 1 to 3 have been finally rejected under the judicially created doctrine of double patenting based on undue extension of the exclusionary right granted by patent, *i.e.*, double patenting of the obviousness-type. The claims of the Willis patent form the basis of this rejection. We shall affirm this rejection.

This rejection could be summarily affirmed since appellant has not argued the facts. He has only made the somewhat perplexing comment in the principal brief that the examiner "has not cited an opinion of a court that supports the rejection." This statement is set forth immediately after the statement recognizing that "obviousness double patenting is a judicially created doctrine." At any rate, in the supplemental examiner's answer, the examiner did cite one of the many prior decisions which could have been relied on, *i.e.*, *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). No further argument on this issue was presented in appellant's reply brief. We shall, however, add comments on the factual issues involved in the rejection for completeness.

The patentee of the Willis patent is the same entity as the present applicant. The patent claims and the present claims both recite polymers "comprising" certain specific polymeric units. According to the patent disclosure, the polymers therein

claimed do comprise the hydroxyl group bearing units in appellant's claims (see column 9, lines 48 to 51), and according to appellant's present specification, appellant's claimed polymers do comprise some of the ketone carbonyl containing groups of the patent claims (see page 5, line 18; page 7, lines 23 to 28; and page 8, lines 8 to 9). Thus, there is an indeterminate but potentially great amount of overlap between the subject matter covered by the patent claims and the here appealed claims. Thus, there was more than adequate basis for the examiner's rejection. *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

Claims 14 to 20 have been rejected under the first paragraph of 35 U.S.C. § 112 as lacking enablement in the specification with respect to several different aspects of the process claimed. These rejections, however, set forth no specific reason for lack of enablement but appear to rely on sections of the ***Manual of Patent Examining Procedure*** as requiring that the claims be limited to exemplified species. Since this rejection fails to articulate any recognizable basis to deny patentability under this section of the statute, we must summarily reverse it.

The examiner's rejection of claims 1 to 3 is affirmed. The rejection of claims 14 to 20 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

MELVIN GOLDSTEIN)
Administrative Patent Judge)
)
)
VINCENT D. TURNER)
Administrative Patent Judge) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES
)
CHARLES F. WARREN)
Administrative Patent Judge)

Appeal No. 94-0997
Application 07/529,304

Keith M. Tackett
Shell Oil Company
One Shell Plaza
P. O. Box 2463
Houston, TX 77252